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Reply to Office Action of 26 January 2005

REMARKS

Upon approval of the undersigned's request for entry of the present amendment to dependent claim 6, and to independent claims 16, 19, 20, 22, 23, 26, 27, 32-36, and 38, all previously pending claims remain pending. Claim 6 was amended to correct an objection as requested by the Examiner. The independent claims were amended to include limitations similar to those recited in the allowable claims. Therefore it is respectfully asserted that the claims, as pending, are allowable over the art of record.

*Formalities*

The current rejection raises new objections to the figures, based on language recited in certain identified claims added in the previous amendment. Specifically, the rejection asserts that certain identified features of these identified claims are not shown. These objections are respectfully requested to be reconsidered. Specifically:

Image Capture/Image Storage/Image Transmission (Claims 28-30 respectively): Claim 27 recites an imaging system including the transfer engine and the print registration system as described in the specification. Claim 28 simply affirmatively recites that the imaging system is an image capture system. The Figures show the transfer engine (element 110) and the print registration system (element 115). The specification as originally filed discusses that the imaging system may include a computing system, a camera, a scanner, a video camera, or the like. (See, for example, Page 4, lines 14-22.) Thus the undersigned believes that the feature is suitably shown in the Figures sufficient to meet the requirements for patentability.

Stenciling/Stamping (Claims 32 & 33): Each of these claims simply affirmatively recite that the transfer engine uses a particular type of transfer system (i.e., stenciling and stamping respectively). The specification as originally filed discusses that an image transfer engine (shown as element 110) may include different modalities and conventional printing system, two of which were identified as stenciling and stamping. (See, for example, Page 3, lines 21-27.) Thus the undersigned believes that the feature is suitably shown in the Figures sufficient to meet the requirements for patentability.

Transfer Registration System & "Bottom-Most" (Claims 41, 46, 48). Claims 41, 46, and 48 each recite that a transfer medium element is a bottom-most transfer media of a pad in a print registration system. The pad (120) and print registration system (115) are each shown so the

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rejection appears to request that a particular one embodiment orientation be expressly shown. The Specification as filed teaches that the print-registration system may locate a bottommost transfer medium, or other portion of pad 120, to the appropriate location of a transfer engine. (See, for example, Page 5, lines 14–18.) Thus the undersigned believes that the feature is suitably shown in the Figures sufficient to meet the requirements for patentability.

### *Rejections*

Claims 14, 21, 23–25, and 42–49 are all rejected as failing to comply with the written description requirement. The claims assertedly contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Specifically, the rejection asserts that the “Applicant has not provided a description of how the media that is *adhered* to the pad is removed. The media stripper shown in the drawings appears to simply be a roller.” (Emphasis in Original.)

First, the pad elements are asserted to be releasably secured to one another rather than adhered. One well-known example of suitable pad elements are “Sticky Notes” from 3M as taught in the specification. Thus the rejection’s characterization of the pads is in error.

Second, the specification (as originally filed) includes a discussion of the media stripper. Specifically (see, for example, page 5, lines 19–23):

Registration system 115 also includes, in some implementations, a stripper 145 for pulling a single transfer medium off pad 120, either before image transfer or after. Stripper 145, depending upon its functions, may be implemented in numerous different ways. A simple implementation includes a blade or roller that slides between a sheet and the remainder of the pad to lift, separate and remove the sheet.

Third, the drawings (both Figure 1 and Figure 2) show stripper 145 and only in Figure 2 is the stripper shown as simply a roller. Such a characterization is consistent with the description and is representative of the stripper system. The roller is but one disclosed embodiment, when disposed as provided and taught in the application.

Fourth, the claims as originally filed (see, for example, claim 13) recite a media stripper. As the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. explain (See M.P.E.P.

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Section 2163) when considering a Written Description rejection of contents of an originally filed claim, there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. A fair and reasonable reading of the entire guidelines supports the undersigned's position that the current rejection of the claims based upon the media stripper and a lack of written description is insufficient as a matter of law.

The rejection does not appear to consider that the limitation is present in the originally filed specification and the claims. The rejection's simple identification that a specific disclosed and taught embodiment is presented in one of the figures is insufficient to rebut the strong presumption of adequacy of the written description in this case. Therefore the rejection of the claims under 35 USC Section 112, first paragraph for failure to meet the written description requirement is respectfully requested to be reconsidered and withdrawn.

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Previously pending claims other than claims 25, and 14, 21, and 42-49 (held allowable) had been substantively rejected under 35 USC Sections 102 and 103, however it is respectfully asserted that those rejections are now moot in light of the present amendments. The new claims are respectfully asserted to include limitations distinguishing themselves from the cited references.

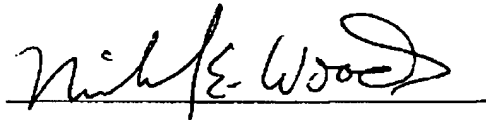
Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Michael E. Woods, Applicants' Attorney at (415) 388-0830 so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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Date



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